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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,357	05/22/2002	Seiji Asaoka	1887	9914
7590 06/16/2004			EXAMINER	
Karen G Kaiser National Starch & Chemical Company Box 6500 Bridgewater, NJ 08807-0500			WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,357

Applicant(s)

ASAOKA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 10-20 are pending.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 2/6/04 to the rejection of claims 10-20 made by the Examiner under 35 USC 103, 112, and the judicially created doctrine of double patenting have been fully considered and deemed not persuasive.

Double Patenting Rejection Maintained

The provisional rejection of claims 10, 15-16, 19, 20 under the judicially created doctrine of double patenting as being unpatentable over claims 14, 24-27 of copending Application No. 10/049,361 is MAINTAINED for the reasons set forth in the Office Action mailed 11/6/04, and those found below.

Applicant argues, "10/049,361 also claims a cosmetic composition with two defined components, a polyurethane and a silicone polymer. . . The Examiner states that a dependent claim of the present case states that the urethane resin has at least one polysiloxane bond. This is clearly different from having a urethane resin and a silicone polymer". This argument is not persuasive. It is respectfully pointed out that the instant specification teaches that the polysiloxane bond comes from a silicone polymer. Applicant's argument regarding the behavior is not persuasive, as the claims are directed to a product and not to behaviors.

112 Rejection Maintained

The rejection of claims 17-19 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 11/6/04, and those found below.

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Applicant directs the Examiner to page 14, line 17 of the specification, and states, "it is clear that it is not actually that the polyurethane is a liquid, but that the urethane is dispersed or dissolved in an aqueous liquid". This argument is not persuasive. It is respectfully pointed out that the instant claims recite the amphoteric resin as an aqueous liquid. To overcome this rejection, the Examiner respectfully suggests that Applicant amend the claims to recite the resin in an aqueous liquid, as recited on page 14 of the instant specification.

103 Rejection Maintained

The rejection of claims 10, 14-15, 17-18, 20 under 35 U.S.C. 103(a) as being unpatentable over Bhatt et al. (2002/0071811) in view of Kim (6335003) is MAINTAINED for the reasons set forth in the Office Action mailed 11/6/02, and those found below.

The rejection of claims 11-13, 16, 19 under 35 U.S.C. 103(a) as being unpatentable over Bhatt et al. (2002/0071811) in view of Kim (6335003), as applied to claims 10, 14-15, 17-18, 20, and further in view of de la Poterie et al. (5,972,354) and further in view of Bolich et al. (5,100,658) is MAINTAINED for the reasons set forth in the Office Action mailed 11/6/02, and those found below.

Applicant argues, "the reference does not teach the use of tertiary amino groups, nor that the carboxyl group and tertiary amino group should be in the same molecule. Further Bhatt neither teaches nor suggests that the cosmetic composition contain a water soluble resin in addition to the polyurethane". This argument is not persuasive. First, it is respectfully pointed out that this is a 103-obviousness rejection and not a 102-anticipation rejection. Thus, Bhatt et al. is not relied upon to teach all the limitations of the instant claims. It is respectfully pointed out that Kim et al. is relied upon to teach tertiary amines. Second, it is respectfully pointed out

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that the polyurethane resin of Bhatt et al. is a water soluble resin. There is no limitation in the instant claim that recites “a water soluble resin in addition to the polyurethane” as argued by Applicant.

Applicant argues, “to form the polyurethane of the present invention, one skilled in the art would need to not only choose to combine the two references, but also choose that the polyurethane should be amphoteric (not cationic as in Kim), and to substitute tertiary amino groups out of the long list given by Kim”. This argument is not persuasive. First, it is respectfully pointed out that Kim et al. is relied upon for its teachings of polyurethane resins, wherein diamines and tertiary amines are taught as interchangeable. There is no choosing between amphoteric and cationic, as argued by Applicant. The Examiner further points out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In the instant case, Kim teaches the interchangeability of diamines and tertiary amines in polyurethane resins comprising carboxyl groups.

Applicant argues, “Even if one skilled in the art would choose to combine the two references in such manner, they would not result in the present invention”. This argument is not persuasive. First, while Applicant has made such a statement, Applicant has provided no rationale to support this statement. Second, as pointed out above, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.

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Applicant argues, “there is no teaching or suggestion in either reference that it would be advantageous to have these two groups on the same molecule. Further, neither reference teaches the advantage of including a water soluble resin in the cosmetic composition to increase durability”. This argument is not persuasive. First, the argument is not commensurate in scope with the instant claims, as the claims are not directed to advantages, but to a product. If Applicant is attempting to establish unexpected results, the Examiner respectfully directs Applicant to the guidelines for showing unexpected results. It is applicant’s burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be “clear and convincing” *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). Second, it is respectfully pointed out that the amines of the carboxylated polyurethane resins of the combined reference are in one molecule.

Applicant states, “Applicant does not understand the Examiner’s statement ‘the combined resin is a water-soluble resin’, as two components, both the polyurethane and the water soluble resin, are claimed”. This argument is not persuasive. As pointed out above, the instant independent claim does not require the two resins to be distinct.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER